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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,878	02/02/2004	Douglas Rowitch	030186U2	1054
23696	7590	03/31/2006	EXAMINER	
QUALCOMM, INC 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			BALAOING, ARIEL A	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/770,878	ROWITCH ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Ariel Balaoing	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 January 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                         |                                                                             |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                         | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 01/19/2006 have been fully considered but they are not persuasive.

Regarding claim 1, the applicant argues “[Kingdon does not describe] any element, or more particularly an MPC, that authorizes the LBS application *running on the mobile station*. Kingdon describes verifying an identity and authority of a third party agency that is requesting the location of a mobile device. . . . Thus, the portion of Kingdon relied upon by the Examiner does not refer to an application running on a mobile station, and does not even refer to an application. Instead, the portion refers to a requesting agency, such as a law enforcement agency.” (see pg. 6, paragraph 5 and 6); the examiner respectfully disagrees. The MPC of Kingdon is used to authorize the use of an application (location service) used to position a mobile station (see abstract and Figure 4, 440, 450). Kingdon further discloses that the application can be run from either the network, or within the mobile station (col. 2, lines 19-29; while disclosed in the background, the art is relevant to the invention disclosed in Kingdon). Thus, the MPC authorizes the positioning application of the mobile station.

2. Furthermore, in response to applicant's argument that there is no suggestion to combine the references (see page 7 of the remarks), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both inventions relate to providing authorization to an application within a mobile device of a wireless communication system (See Kingdon, Figure 4 and Kruise paragraph 14).

Regarding the provisional obvious type double patenting, the applicant argues “the claims in the [10/769,420] application are directed to authorization of an application. The instant claims are directed to authenticating a LBS application.” Since an LBS application is seen as an application being run from the mobile device as with the copending application, both sets of claims disclose substantially the same invention. Furthermore, as can be seen on independent claim 8 of application 10/769,420, authentication of a LBS application is performed.

3. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Election/Restrictions***

4. Newly submitted claims 8-12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions are distinct, each from the other because of the following reasons:

Claims 1-7 and 8-12 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP §

806.05(e)). In this case claims 8-12 are drawn to specifics of a positioning engine locating within a mobile device and the processing of position information (class 455/456.6). Examined claims 1-7 are drawn to the process of authenticating a location based application of a mobile device (class 455/411). Claims 1-7 does not mention the use of the positioning techniques presented in claims 8-12.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRUIS et al (US 2004/0242209 A1) in view of KINGDON (US 6,138,003).

Regarding claim 1, KRUIS discloses a method for authenticating an application run on a mobile station (abstract), including: a. attempting to run an application on the mobile station (abstract; paragraph 46, 47); b. requesting authentication of the application (paragraph 38-40); d. if the application is authenticated, then receiving within the mobile station information required to continue running the application in response to the application being authenticated (paragraph 86); and e. if the application is not authenticated, then failing to receive at least some information required to run the

application in response to the application not being authenticated (paragraph 53). However, KRUIS does not disclose wherein the application is a LBS application; and c. communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the application. KINGDON discloses wherein the application is a LBS application; and communicating directly with a mobile positioning center (MPC) in order to have the MPC fulfill the request for authentication of the application (Figure 4; col. 2, lines 19-29; Figure 4; col. 2, lines 19-29; column 4:line 54-column 5:line 6; column 6:lines 8-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to communicate with a MPC to fulfill the request for authentication, as taught by KINGDON, as this allows the monitoring of program usage to a specific communication region.

Regarding claims 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. KRUIS further discloses further including: a. if the application has not be authenticated, receiving a response message indicating that authentication failed (paragraph 53); and b. in response to receipt of the response message, halting the application (paragraph 53).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. KRUIS further discloses wherein the application that is attempted to run on the mobile station requires authentication in order to receive all required information (paragraph 53). However, KRUIS does not disclose wherein the required authentication is from the MPC. KINGDOM discloses wherein authorization is

received from the MPC (Figure 4; col. 2, lines 19-29; column 4:line 54-column 5:line 6; column 6:lines 8-21). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to communicate with a MPC to fulfill the request for authentication, as taught by KINGDON, as this allows the monitoring of program usage to a specific communication region.

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. KRUIS further discloses wherein the authentication of the application allows the mobile station to communicate with other components (Figure 2; abstract; paragraph 53). However, KRUIS does not disclose wherein the authentication is by a MPC. KINGDON discloses wherein the authentication of the application by the MPC allows the mobile station to communicate with other components (column 6:lines 30-62). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to allow the mobile station to communicate with a positioning entity after being authenticated by the MPC, as taught by KRUIS, as this can keep track of monitoring services that wish to access the mobile stations position.

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, KRUIS does not disclose wherein the other components include a position determination entity. KINGDON discloses wherein the other components include a position determination entity (column 6:lines 30-62). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify KRUIS to allow the mobile station to communicate

with a positioning entity after being authenticated by the MPC, as taught by KRUIS, as this can keep track of monitoring services that wish to access the mobile stations position.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRUIS et al (US 2004/0242209 A1) in view of KINGDON (US 6,138,003) as applied to claim 1 above, and further in view of TORABI (US 6,754,482 B1).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of KRUIS and KINGDON does not disclose wherein the authentication of the application to be run on the mobile station is independent of other authentication operations to be requested by the mobile station for the purpose of authenticating telephone communication. TORABI discloses wherein the authentication of the application to be run on the mobile station is independent of other authentication operations to be requested by the mobile station for the purpose of authenticating telephone communication (column 3:lines 23-67). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of KRUIS and KINGDON to include independent authentication of applications, as taught by TORABI, as this allows the application to be launched faster.

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, the combination of KRUIS and KINGDON does not disclose wherein the authentication of the application to be run is further independent of other authentication operations to be requested in order to

authenticate other applications. TORABI discloses wherein the authentication of the application to be run is further independent of other authentication operations to be requested in order to authenticate other applications (column 3:lines 23-67; column 4:lines 44-53). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of KRUIS and KINGDON to include independent authentication of applications, as taught by TORABI, as this allows the application to be launched faster.

***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10769,420 in view of KRUIS et al (US 2004/0242209 A1).

Claims 1-7 of the instant application includes all of the limitations of claims 1-7 of copending Application No. 10/769,420 except for:

(From claim 1) e. if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated.

Although the conflicting claims are not identical, they are not patentably distinct from each other. KRUIS teaches wherein if the application is not authenticated, then failing to receive at least some information required to run the application in response to the application not being authenticated (paragraph 53). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the instant invention to include a method to limit information needed to run an application if authentication has failed, as taught by KRUIS, as this provides a safeguard against unnecessary use of system resources. Also it is inherent from copending claim 1 that if the application is not authenticated, then information required to run the application will not be received.

Furthermore, since an LBS application is seen as an application being run from the mobile device as with the copending application, both sets of claims disclose substantially the same invention. Furthermore, as can be seen on independent claim 8 of application 10/769,420, authentication of a LBS application is performed.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing  
Art Unit 2617 AB

3/22/2006

AB

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER